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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,654

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John Dicesare

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EXAMINER

COZART, JERMIE E

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

12/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,654	Applicant(s) DICESARE, JOHN	
	Examiner Jermie E. Cozart	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-6 and 11 is/are rejected.
- 7) ☒ Claim(s) 12-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Janssen et al. (WO 01/62410 A2).

Regarding **claim 11**, Janssen discloses manufacturing a hydroformed member comprising the steps of: providing a tubular blank (24) defined by a blank wall; positioning a wall-thinning element (52) along the die surface; introducing pressurized fluid into the blank (24) to force the blank wall against the die surface and the wall-thinning element (52) to reduce the thickness of the blank wall adjacent the wall-thinning element (52) and form a removable wall section (86) in a portion of the hydroformed member; removing the removable wall section (86) to form an opening () in the hydroformed member (28), wherein the removing step includes striking the removable wall section (86) using a punch (52). *See column 3, line 43 – column 4, line 49, and figures 1-5 for further clarification.*

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marando (5,816,089).

Regarding **claim 4**, Marando discloses manufacturing a hydroformed member (28) comprising the steps of: providing a blank (28) defined by a blank wall; placing the blank in a die assembly (22, 24) having a die cavity (26) defined by a die surface; expanding (col. 6, lines 31-37) the blank to force the blank wall against the die surface and form the hydroformed member; conforming a portion of the blank wall against a wall-thinning element (52) positioned along the die surface to form a removable wall section (28a) in a portion of the blank wall; and removing the removable wall section from the blank wall to form an opening (53) in the hydroformed member (28) using a punch (50).

Regarding **claim 5**, Marando discloses the expanding step includes introducing pressurized fluid (col. 6, lines 31-37) into the die cavity (26).

Regarding **claim 6**, Marando discloses the removing step includes striking the removable wall section (28a) using a punch (50, see Fig. 3, 3a).

Marando, however, does not disclose the removing step including striking the removable wall section multiple times (claim 2), or moving the hydroformed member out of the die assembly prior to the step of removing the removable wall section from the blank wall to form the opening in the hydroformed member.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the removing step of

Marando include striking the removable wall section multiple times, and to move the hydroformed member of Marando out of the die assembly prior to the step of removing the removable wall section from the blank wall to form the opening in the hydroformed member because Applicant has not disclosed that the removing step including striking the removable wall section multiple times, or moving the hydroformed member out of the die assembly prior to the step of removing the removable wall section from the blank wall to form the opening in the hydroformed member provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the teachings of Marando because the opening is effectively formed in the hydroformed member.

Therefore, it would have been an obvious matter of design choice to modify Marando to obtain the invention as specified in claim 2.

Allowable Subject Matter

5. Claims 1-3 are allowed.
6. Claims 12-18 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of these limitations of their respective base claims and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 9/4/08 have been fully considered but they are not persuasive.

With respect to **claim 4**, Applicant argues that it would not be obvious to one having ordinary skill in the art as a matter of obvious design choice to move the hydroformed member out of the die assembly prior to the step of removing the removable wall section because it would render much of the Marando invention inoperable.

In response, the Examiner maintains that Marando and the present achieve the same end result in that a hydroformed is provided with a hole/opening. Applicant has not shown how the removing the blank from the die then removing the removable wall section provides an advantage, is used for a particular purpose, or solves a stated problem. In addition, moving the hydroformed member out of the die assembly prior to the step of removing would not render Marando to be inoperable because the wall slug still could be removed once the pressure is released.

Applicant also argues that Marando fails to suggest associating the step of conforming a portion of the blank wall against the wall-thinning element with forming a removable wall section as recited by claim 4.

In response, the Examiner maintains that Marando does disclose conforming a portion of the blank wall against the wall-thinning element (52) with forming a removable wall section (28a) as recited by claim 4. *See figures 2, 3, and 3a for further clarification.*

Applicant also argues that no reason exists why one skilled in the art would discard the method of providing in-die hole piercing and slug removal as taught to Marando to perform the claimed process without the use of impermissible hindsight reasoning.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie E. Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jermie E Cozart/
Primary Examiner, Art Unit 3726

December 6, 2008